

Remarks

Claims 2 to 25 are pending in this application. Claims 2 to 4, 6 to 12, and 15 to 24 have been withdrawn from consideration. Claims 5, 13, 14, and 25 are subject to examination, and have been rejected. Applicants filed an Amendment After Final on May 29, 2009 that has been entered. The amendment above and the following comments address the examiner's June 12, 2009 Advisory Action in which the examiner indicated that the amended claims would still be rejected on the art of record because they recite a "use" of a product, and the previous rejections would still apply. Applicants respectfully submit that claim 25 as amended above, traverses the rejections and the examiner's comment about "use," and that the claims are allowable.

Rejections Under 35 U.S.C. §102

In the Final Action, claims 5 and 25 were rejected under 35 U.S.C. §102(e) as being anticipated by *Blasé* (U.S. Patent 6,354,070). Claim 25 was also rejected under 35 U.S.C. §102(b) as being anticipated by *Fukao* (U.S. Patent 5,836,148).

To maintain a rejection under 35 U.S.C. §102(b), all of the elements of each claim must be disclosed in a single reference. The test for anticipation requires a strict, not substantial, identify of corresponding claim elements. *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1334-35, 2008 U.S. Appl. LEXIS 8404, 27-28 (Fed. Cir. 2008). Applicants respectfully submit that amended claim 5 and 25 are not anticipated by either *Blasé* or *Fukao*, for the reasons stated below.

Rejection Under 35 U.S.C. §103

In the Final Action, claims 13 and 14 were rejected 35 U.S.C. §103(a) as being obvious over *Blasé*. Applicants respectfully disagree because claims 13 and 14 depend from amended claim 25, they are distinguishable from *Blasé* for the same reasons that apply to claim 25, and they are distinguishable for the additional reasons stated below.

To establish a *prima facie* case of obviousness a three-prong test must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available among those of ordinary skills in the art, to modify the reference. Second, there must be a reasonable expectation of success found in the prior art. Third, the prior art reference must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). See M.P.E.P. §2143. This is modified by the motivation flowing from (1) the prior art references, (2) the knowledge of the skilled technologist, or (3) the nature of the problem being solved. *In re Dembiczak*, 775 F. 3d 994 (Fed. Cir. 1999). This rule has been clarified as being flexible in allowing a reason to combine that may not be limited to a teaching, suggestion or motivation. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007).

Obviousness is not to be read into an invention on the basis of the Applicant's own statements; that is, the prior art must be viewed without reading into that art Applicant's teachings. *In re Murray*, 268 F. 2d 226, 46 CCPA 905; *In re Sporck*, 301 F.2d 686, 49 CCPA 1039. The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of Applicant's disclosure, make the invention as a whole, obvious. *In re Leonor*, 395 F.2d 801, 55 CCPA 1198.

The Federal Circuit has strictly prohibited the use of the patent or invention at issue as a tool to combine prior art references to find obviousness. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). The obviousness of a claim should not be decided through the use of the claim as a "guide through a maze of prior art references which combine the right references in the right ways so as to achieve the result of the invention, as defined by the asserted claim." *General American Transportation Corp. v. Cryo-Trans, Inc.*, 893 F.Supp 774, 793 (N.D. Ill. 1995). "The tendency

to resort to 'hindsight' based upon Applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art."

M.P.E.P. §2142.

Amendments

Claim 25 is amended to address the examiner's comment that the claims are "directed towards the use of the device." (Advisory Action, pg. 3.) This comment suggests that the examiner believes there is insufficient structure recited in the claim to distinguish the prior art. Accordingly, claim 25 has been amended to recite the spacing between a connection and a common contact surface to distinguish the cited references, and to recite sufficient structure to overcome the examiner's position on use of the device.

The line guidance unit described throughout the specification has an arc-shape when in an unloaded condition, which is the result of the contact surfaces on adjacent segments engaging one another in a way that "pretensions" the line guidance unit for resisting loads. Inherent in these descriptions is that a reaction force is carried by the connection between the support strip and the segments to prevent the common contact surfaces from disengaging. Also, inherent in the descriptions is that the distance between the connection and the contact surface on a segment is short enough that the line guidance unit will become arc-shaped when in an unloaded condition. Further, when the line guidance unit is in a loaded condition with lines, it will tend to straighten due to forces caused by the line load. Thus, it is this *structure* between connection and common contact surface that yields the pretensioning of the line guidance unit. These features and results are not disclosed in the prior art.

In the Final Action, the examiner noted that the loads and pre-tensioned features were not specifically recited in the claims before the After Final Amendment. While this was true, Applicants submitted that the claims before being amended properly recited these features. Nonetheless, claims 5 and 25 were amended to recite that the line guidance unit is pre-tensioned in an unloaded condition when lines are not in the line channel, and resists loads when lines are installed in the channel. Applicants believed that the Amendment After Final satisfied the previous basis for the Final rejections.

Further, the examiner had included in the Final Action, Fig. 2 of *Blasé* to illustrate the common contact surfaces of that device. It is true that *Blasé* can be arc-shaped, but the arc-shape is *not* due to contact between the common contact surfaces. Instead, that shape is a result of the line guidance unit being bent by external forces and not as a result of a spacing between connection and common contact surfaces, as recited in amended claim 25. The *Blasé* common contact surfaces “form a closed side wall when the cable guide is extended” (Col. 4, lines 48 to 49), but the unit is not arc-shaped. Further, as Fig. 2 shows, when the line guidance unit is not extended (or arc-shaped), the common contact surfaces are not engaged and, thus, have no affect on the shape or pre-tensioning of the unit. Thus, *Blasé* is not a teaching that the common contact surfaces pre-tension the cable guide into an arch-shape when it is in an extended position. Instead, *Blasé* discloses that the contact surfaces are actually spaced apart when the unit is arc-shaped.

Applicants amended claim 25 to also recite that the contact surfaces are spaced apart from the support strip-to-contact surface a distance that causes the line guidance unit to be pre-tensioned and arc-shaped when the line guidance unit is in a substantially unloaded and extended position. Of course, the line guidance unit is slightly more extended in a loaded state, but claim

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25 recites that line forces or other forces are not causing the arc-shape. Applicants respectfully submit that amended claims 5 and 25 are not anticipated by *Blasé*.

The links of *Fukao* also appear to have side walls that form a closed wall when the guide is extended, and this arrangement will apparently resist loads when the guidance unit is in a loaded condition. Nonetheless, the line guidance unit of *Fukao* is not pre-tensioned or arc-shaped when in the extended and unloaded condition and there is no disclosure of a spacing between connection and contact surface that causes the line guidance unit to be arc-shaped. Thus, claims 5 (which depends from claim 25) and 25 are not anticipated by *Fukao* either.

Applicants respectfully submit that pursuant to 35 U.S.C. §112 paragraph 4, the dependent claims incorporate by reference all the limitations of the claim to which they refer and include their own patentable features, and are therefore in condition for allowance. Therefore, Applicants respectfully request the withdrawal of all claim rejections and prompt allowance of the claims.

Claims 13 and 14 would not have been obvious for the reasons stated above and further because the arbitrary shapes of sidewalls in *Blasé* are not a teaching, suggestion, or motivation to pre-tension a line guidance unit and form it into an arc-shape when in an unloaded and substantially extended position. *Blasé* fails to teach that pre-tensioning is desirable, and therefore, fails to teach that the shapes of the sidewalls as being trapezoidal (claim 13) or rhomboidal (claim 14) would result in the benefits of pre-tensioning a line guidance unit. Thus, claims 13 and 14 would not have been obvious to one of ordinary skill in the art are now allowable.


Finally, Applicants respectfully submit that claim 25, as amended, is not a way of *using* a line guidance unit, but rather a structure that results in the stated line guidance conditions.

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Conclusion

For the foregoing reasons, the amended claims are allowable, and Applicants respectfully request that this case be passed to issue.

Respectfully submitted,



Jeffrey W. Smith, Reg. No. 33455
Attorney for Applicant
SMITH LAW OFFICE
8000 Excelsior Drive, Suite 301
Madison, WI 53717
(608) 824-8300